SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

October Term, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

v.

FRANK P. DOYLE, *et al.*,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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TABLE OF CONTENTS

	PAGE
Citations to Opinions Below	1
Jurisdiction	2
Question Presented	2
Statutory Provision Involved	2
Statement of the Case	3
Reasons for Granting the Writ	7
I—The decision below is the most recent example, and is representative, of the continuing and deepening conflict which is developing between the decisions of the Courts of Appeals which have interpreted 35 U.S.C. §24	7
II—The conflicts between the Circuits respecting the jurisdiction conferred by 35 U.S.C. §24 is likely to lead to further and serious injustice	9
III—The decision below constitutes an improper refusal to accept the jurisdiction conferred upon the federal courts by Congress	11
Conclusion	13
Appendix:	
A—Opinion of Court Below	1a
B—Judgment of the Court Below	9a
C—Opinion of District Court	10a
D—Rule 34 Motion	11a
E—District Court Opinion in Doyle Discovery	15a

TABLE OF AUTHORITIES

PAGE

Cases:

Babcock & Wilcox Co. v. Combustion Engineering, Inc., 430 F.2d 1177 (2d Cir. 1968), *aff'g mem.* 314 F. Supp. 235 (D. Conn. 1968) 6

Babcock & Wilcox Co. v. Foster Wheeler Corp., 173 USPQ 480 (D.N.J. 1972) 12

Cohens v. Virginia, 19 U.S. (Wheat.) 264 (1821) 12

Duffy v. Barnes, 508 F.2d 205 (3rd Cir. 1975) 7

Frilette v. Kimberlin, 508 F.2d 205 (3rd Cir. 1975) 6, 7, 8, 9, 12

Gladrow v. Weisz, 354 F.2d 464 (5th Cir. 1965) 6

Hickman v. Taylor, 329 U.S. 495 (1947) 10

Hogan v. Zletz, 151 USPQ 103 (N.D. Okla. 1966) 6

In re Natta, 388 F.2d 215 (3rd Cir. 1968) 8

Korman v. Shull, 184 F. Supp. 928 (W.D. Mich. 1960) 6

Lomex v. Kihara, 175 USPQ 538 (D.D.C. 1972) 6

Natta v. Hogan, 392 F.2d 686 (10th Cir. 1968) 6

Natta v. Zletz, 379 F.2d 615 (7th Cir. 1967) 6

Sheehan v. Doyle, 181 USPQ 64 (D. Mass. 1973) 6

United States v. Proctor & Gamble Co., 356 U.S. 677 (1958) 10

Statutes:

28 U.S.C. §1254(1) 2

35 U.S.C. §24 ..... 2, 3, 5, 6, 7, 8, 9, 11, 12

35 U.S.C. §135 3

Rules:

Fed. R. Civ. P. 34 5

Fed. R. Civ. P. 45 5

IN THE

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October Term, 1974

No. .....

JOHN C. SHEEHAN,

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FRANK P. DOYLE, *et al.*,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Petitioner, John C. Sheehan, prays that a Writ of Certiorari be granted to review the judgment of the United States Court of Appeals for the First Circuit entered in this proceeding on March 31, 1975.

Citations to Opinions Below

The Opinion of the Court of Appeals for the First Circuit is reported at —— F.2d ——; 185 U.S.P.Q. 489 (1975) and is reproduced in Appendix A hereto, *infra*.

The opinion of the District Court for the District of Massachusetts, unofficially reported at 184 U.S.P.Q. 291, is printed in Appendix C, *infra,* page 10a.

Jurisdiction

The judgment of the United States Court of Appeals for the First Circuit was entered on March 31, 1975 (Appendix B, *infra,* page 9a). The present petition for certiorari was filed within 90 days of the original judgment.

This Court's jurisdiction is invoked under 28 U.S.C. §1254(1).

Question Presented

Does 35 U.S.C. §24, which provides in relevant part:

> "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

mean that the federal courts are statutorily authorized and required to assist a party in contested Patent Office interference proceedings to obtain as a matter of right the full range of discovery contemplated by the Federal Rules of Civil Procedure?

Statutory Provision Involved

§24 Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the applica-

tion of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena. [35 U.S.C. §24 (1952) (emphasis supplied)]

Statement of the Case

This case arises from a pending U.S. Patent Office interference proceeding[1] declared under the provisions of 35 U.S.C. §135 between an issued patent of petitioner and a patent application of respondents and involves the petitioner's use of 35 U.S.C. §24 in seeking discovery in aid of the interference proceeding.

1. The course of proceedings in an interference is described in footnote 1 of the Opinion of the Court below (Appendix A).

Petitioner, John C. Sheehan, is the inventor of United States patent No. 3,159,617, assigned to Arthur D. Little, Inc., a corporation of Massachusetts. The subject matter of the patent is a method for producing penicillins, both "natural" and synthetic.

Respondents are British subjects and residents of Great Britain and are the applicants of a pending U.S. patent application assigned to Beecham Research Laboratories Ltd. (BRL), a British corporation.

The Patent Office declared an interference between respondents' application and petitioner's patent solely on the basis of certain self-serving *ex parte* affidavits filed on behalf of respondents in 1969. The affidavits described experimental work undertaken by BRL in support of its allegations that the disclosure of the Sheehan patent was inoperable, i.e., could not be re-run in the laboratory to produce the compounds obtained by Sheehan, particularly a key intermediate compound 6-APA. Petitioner has challenged the sufficiency of the laboratory procedure and identifying tests used by BRL.

Petitioner, in the interference proceeding, has raised issues relating to the candor of BRL in failing to use, or even discuss, meaningful identification techniques which were available for establishing the presence of the key intermediate 6-APA which they allege was not produced following Sheehan's teachings. Specifically, important questinos were raised by petitioner as to whether the products obtained by affiants were tested using paper chromatographic separation and identification procedures—which is a sensitive procedure that had been developed by BRL

at least as early as 1959. Petitioner has also pointed out to the Patent Office, that although the affiants had stated that extensive experimental work was conducted in Great Britain in accordance with the disclosure of the Sheehan patent, conflicting results which were reported on several runs were left unexplained in the affidavits. These issues have never been answered by BRL.

Petitioner accordingly sought document discovery from respondents and BRL under the provisions of 35 U.S.C. §24 by means of Rule 34 of the Federal Rules of Civil Procedure. Respondents could not be subpoenaed under Rule 45 because they are aliens not present in the United States. Petitioner requested that respondents produce certain background documents and materials relating to the *ex parte* affidavits and the experimental work of BRL to determine whether they had complied with the requirements of strict candor that an applicant must meet in his dealings with the Patent Office. The documents and materials requested are described in petitioner's Rule 34 request attached as Appendix D, *infra*, page 11a.

The District Court of Massachusetts, on October 9, 1974, under the then-prevailing construction of 35 U.S.C. §24, ordered respondents to produce the documents and materials sought. On appeal, the U.S. Court of Appeals for the First Circuit reversed the order of the District Court, holding that 35 U.S.C. §24 does not confer jurisdiction on the District Court, acting on its own, to grant Rule 34 discovery directly, but rather applies only to the use of subpoenas (as provided in Rule 45) in aid of discovery authorized by the Patent Office. The First Circuit

specifically adopted the reasoning supporting the recent ruling by the Third Circuit in *Frilette* v. *Kimberlin*, 508 F.2d 205 (Jan. 27, 1975) (*en banc*). In the *Frilette* decision, the Third Circuit not only reversed its own prior decisions, but adopted an interpretation of the statute which at the time squarely conflicted with the decisions of four other Circuit Courts of Appeals (Second[2], Fifth[3], Seventh[4] and Tenth[5]) and the district courts of three additional circuits (Western District of Michigan[6], Northern District of Oklahoma[7], District of Columbia[8] and District of Massachusetts[9]).

Petitioner has himself been caught in this relatively recent shift in judicial construction of 35 U.S.C. §24. As a result of discovery proceedings initiated against petitioner by respondent in the District of Massachusetts in 1973 (prior to *Frilette*) that court ordered compliance with a subpoena *duces tecum*. The District Court had ordered the discovery under the then-prevailing rulings which had uniformly held that 35 U.S.C. §24 authorized the federal courts to grant broad discovery to interference parties. (See the opinion of Judge Garrity of November 20, 1973,

2. *Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.*, 430 F.2d 1177 (2d Cir. 1968), *aff'g mem.* 314 F. Supp. 235 (D. Conn. 1968).

3. *Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965).

4. *Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967).

5. *Natta* v. *Hogan*, 392 F.2d 686 (10th Cir. 1968).

6. *Korman* v. *Shull*, 184 F. Supp. 928 (W.D. Mich. 1960).

7. *Hogan* v. *Zletz*, 151 USPQ 103 (N.D. Okla. 1966).

8. *Lomex* v. *Kihara*, 175 USPQ 538 (D.D.C. 1972).

9. *Sheehan* v. *Doyle*, 181 USPQ 64 (D. Mass. 1973).

Appendix E, *infra*, page 15a.) No appeal was taken from this order, and respondents obtained extensive discovery from petitioner.

Reasons for Granting the Writ

I

The decision below is the most recent example, and is representative, of the continuing and deepening conflict which is developing between the decisions of the Courts of Appeals which have interpreted 35 U.S.C. §24.

The judicial construction of 35 U.S.C. §24 by the court below is in direct and irreconcilable conflict with four of the five Circuit Courts which had previously considered the question.

The decision below adopted the arguments and analysis of the Third Circuit in *Frilette et al.* v. *Kimberlin et al.*, 508 F.2d 205 (3d Cir. 1975) (*en banc*). A Petition for Certiorari was filed from the decision in *Frilette* (No. 74-1156), and in a companion Third Circuit case, *Duffy* v. *Barnes et al.* (No. 74-1200). The following rulings by this Court were entered on May 19, 1975:

No. 74-1156: "The petition for a writ of certiorari is denied. Mr Justice Douglas and Mr. Justice White would grant certiorari. Mr. Justice Powell took no part in the consideration or decision of this petition."

No. 74-1200: "The petition for writ of certiorari is denied. Mr. Justice Douglas would grant certiorari."

There can be no doubt that the court below recognized that it was adopting a construction of 35 U.S.C. §24 which was to be at odds with the controlling interpretation of that provision by four other Circuits around the country and which the Third Circuit had only recently reached by reversing its own seven-year stand on 35 U.S.C. §24. The decision below admitted that when the case was argued on December 2, 1974,

> "* * * it was accepted among the circuits that had passed on the matter that section 24 authorized discovery beyond that permitted by the Patent Office, and in particular the production of documents from a party by means of a Rule 34 motion.",

citing the decisions of the Second, Third, Fifth, Seventh and Tenth Circuits.

However, the issue presented to the First Circuit was one of first impression, and it did not face the difficult questions which confronted the Third Circuit in *Frilette*, and which apparently prompted Circuit Judge Weis to use the phrase to "bite the bullet" (508 F.2d at 207) in describing that Court's action in overruling its prior decision in *In re Natta*, 388 F.2d 215 (1968).

The fact that the First and Third Circuits have recently adopted a narrow construction of 35 U.S.C. §24, serves only to highlight the disparity of views between these two Circuits and the views of the four other Circuits which have broadly interpreted the statutory authority of §24.

The separate dissenting opinions of Judge Van Dusen and of Judge Adams (with which Judge Van Dusen con-

curred) clearly point up the problems created by the majority opinion in the *Frilette* case which was adopted by the decision below.

We respectfully submit that the conflict between the Circuits is firmly set on this narrow issue of law and that it should be promptly resolved by this Court.

II

The conflicts between the Circuits respecting the jurisdiction conferred by 35 U.S.C. §24 is likely to lead to further and serious injustice.

The likely and predictable result of the conflict between the Circuits respecting the jurisdiction under 35 U.S.C. §24 of the federal district courts to afford discovery to opposing parties in contested Patent Office proceedings is that testimony and evidence will be discoverable depending upon the fortuitous happenstance of its geographical location.

Thus, the various parties to a single proceeding can be subjected to completely different burdens of producing evidence and will result in unequal opportunities for conducting their respective inquiries into the facts relating to their opponents' case. Petitioners have, in fact, experienced this unfairness in prior discovery proceedings relating to the same patent interference. Respondents Doyle et al., being the other party to the interference, initiated discovery under 35 U.S.C. §24 in 1973 when there was no conflict between the Circuits on the question of jurisdiction and the reported decisions of the federal courts had generally

favored broad-based Federal Rules discovery. In apparent reliance on this uniform and consistent decisional authority the District Court for the District of Massachusetts entered an order authorizing discovery with which petitioner complied. At that time (i.e., early 1974), there was little basis for recommending that an appeal be taken from the discovery order. Petitioner then instituted discovery against the respondents, which discovery was ordered by the District Court under the then-prevailing law over the respondents' objection, and the appeal to the court below as taken. However, the issues of personal jurisdiction and venue relating to non-resident aliens which prompted the appeal by respondents did not form the bases of the decision below.

Furthermore, it cannot be disputed that the patent interference proceedings within which the decision below arose are anything less than a full trial, albeit conducted under the auspices of an administrative agency. On many occasions this Court has emphasized the importance of the federal discovery rules to making "a trial less a game of blind man's bluff and more a fair contest with the basic issues and facts disclosed to the fullest practicable extent." *United States* v. *Proctor & Gamble Co.*, 356 U.S. 677 at 682-683 (1958); *Hickman* v. *Taylor*, 329 U.S. 495 at 501 (1947).

The present broad construction of 35 U.S.C. §24 by the Courts of Appeals of the Second, Fifth, Seventh and Tenth Circuits will permit a party to develop the relevant facts necessary to permit the Patent Office to best discharge its adjudicative responsibilites. The interpretation of 35

U.S.C. §24 adopted below will frustrate a litigant's access to information essential to a full and fair presentation of all issues relevant to the Patent Office's determination.

There can be little doubt that this conflict will also prompt dissatisfied parties to interference-related discovery proceedings in district courts located in Circuits other than the First and Third to take appeals. Each Circuit will again have to establish its position with respect to the construction of 35 U.S.C. §24. Even if the Circuits were to eventually reach a uniform conclusion, this is a slow, costly and tortuous route to impose upon the development of the law. It will result in unnecessary burdens not only to the parties, but also to the district and Circuit courts, and will unduly burden the public by delaying the final resolution of patent interference proceedings and ultimately the issuance of patents.

III

The decision below constitutes an improper refusal to accept the jurisdiction conferred upon the federal courts by Congress.

The decision below disregards the plain meaning of the following language of 35 U.S.C. §24:

> "The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office."

The construction of this language from the statute by a majority of judicial authority which has previously considered it, leads to the conclusion that the federal courts

are invested by Congress with a mandatory jurisdiction to consider on their merits applications for discovery in interference proceedings pending before the Patent Office tribunal. Assuming that the interpretation which has been uniformly and consistently applied in the Second, Fifth, Seventh and Tenth Circuits is proper, then the decision below clearly misapprehends the intention of Congress. Where Congress has determined to invest the federal courts with such jurisdiction and authority, that jurisdiction must be exercised. For the federal courts to do otherwise would be disruptive of the delicate balance of powers between the executive, legislative and judicial branches of our system of government. In an opinion written prior to the decision of the Third Circuit in *Frilette* which was adopted by the court below, District Judge Coolahan considered the constitutional implications in connection with a determination of the jurisdictional obligations of the courts under 35 U.S.C. §24 and stated:

> "The district court may not defer to the Board[4] by declining to exercise its jurisdiction under 35 U.S.C. §24, as it has always been the law that federal courts may not refuse jurisdiction conferred by the Constitution and statutes of the United States.[5]"
>
> * * *
>
> "5. Cohens v. Virginia, 19 U.S. (6 Wheat.) 264 (1821), in which Chief Justice Marshall, with characteristic vigor and directness, ruled that the Supreme Court 'must take jurisdiction, if it should. * * * We have no more right to decline the exercise of jurisdiction which is given, than to usurp that which is not given. The one or the other would be treason to the constitution.' Id. at 404." *Babcock & Wilcox Co.* v. *Foster Wheeler Corp.*, 173 U.S.P.Q. 480 at 483 (D.N.J. 1972)—[All but footnote 5 omitted.]

In view of the likelihood that the decision below represents an unconstitutional abandonment of compulsory jurisdiction under a federal statute, this Court should grant review.

Conclusion

For all of the reasons stated, it is respectfully requested that this Court grant the present petition for a writ of certiorari to the First Circuit Court of Appeals to review the decision below.

Respectfully submitted,

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APPENDIX

Appendix A

Opinion of Court Below

UNITED STATES COURT OF APPEALS

FOR THE FIRST CIRCUIT

No. 74-1318

JOHN C. SHEEHAN,

Plaintiff, Appellee,

v.

FRANK P. DOYLE *et al.*,

Defendants, Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

Before COFFIN, *Chief Judge,*

McENTEE and CAMPBELL, *Circuit Judges.*

Albert L. Jacobs, Jr., with whom *Jacobs & Jacobs, P.C.*, *Owen F. Clarke, Jr.*, and *Sullivan & Worcester* were on brief, for appellants.

Thomas E. Spath, with whom *N. Dale Sayre, McLean, Boustead & Sayre, Robert J. Horn, Jr., Kenway and Jenney* were on brief, for appellee.

March 31, 1975

CAMPBELL, *Circuit Judge.* This appeal concerns the authority of the District Court for the District of Massachusetts to order discovery in aid of a patent interference

proceeding being conducted before the Board of Patent Interferences in Arlington, Virginia.

Doyle (a name used for three nonresident aliens) is engaged in an interference in the United States Patent Office against Sheehan, a Massachusetts resident. *See* 35 U.S.C. §135. At issue is whether Doyle or Sheehan is the first inventor of processes for the production of penicillin. Doyle has applied for a United States patent, Sheehan already having been granted one covering the same subject matter.

One might suppose that the scope of discovery for use in an interference[1] would be determined by the Patent Office

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1. An interference—an administrative proceeding in the Patent Office—follows a distinct format. After parties have preliminarily stated their positions, 37 C.F.R. §§1.215-1.223, and the period for filing motions has been set, *id.* §§1.231-1.244, the Board of Patent Interferences establishes a schedule for the parties' presentation of evidence by means of deposition, affidavit, or stipulation, *id.* §1.251. The patent applicant who was later in time (the "junior party") is required to produce his evidence first and carries the burden of disproving the order of application. *Id.* §1.257. Testimony is to be taken before an officer authorized to administer oaths, *id.* §1.274, and must always be filed in the Patent Office, *id.* §1.278. If objections are made to the witness or evidence, the evidence shall be taken anyway and the objection noted by the officer. *Id.* §1.275(d). In determining whether to receive or exclude evidence, the Patent Office will "strictly" apply "the established rules of evidence". *Id.* §1.286.

The discovery provision for interferences, Rule 287, only requires a party to furnish his opponent with lists of things, names of witnesses, and copies of documents "upon which the party intends to rely". *Id.* §1.287(a). The senior party—Sheehan in this case—need not provide such materials to the junior party until the junior party has completed taking his testimony. There is no discovery of right of matters which might build an affirmative case for the discovering party or which might undercut the opponent's case-in-chief. However, the Board may grant further discovery privileges, within the scope of the Federal Rules of Civil Procedure, at any time during the proceedings "upon a showing that the interest of justice so requires". *Id.* §1.287(c).

or at least coordinated with the administrative proceeding within its jurisdiction; and Congress has in fact conferred statutory authority upon the Commissioner of Patents to "establish rules for taking affidavits and depositions required in cases in the Patent Office", 35 U.S.C. §23, and the Commissioner has adopted certain rules, *see* note 1 *supra*. But in section 24, Congress has also conferred certain powers upon district courts. Historically section 24 developed to provide for the issuance of subpoenas to compel testimony and evidence required in Patent Office interferences; but a sentence in section 24 inserted by Congress in 1952 has been construed by a number of courts also to allow parties to an interference to obtain at any time broad-based discovery in district courts in separate, self-contained proceedings.[2] *See infra*. Such discovery goes on outside the

2. Section 24, 35 U.S.C. §24, provides in its entirety,

"Subpoenas, witnesses"

"The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesss and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of the court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena." [Emphasis supplied.]

ambit of the Patent Office proceeding and beyond the scope permitted without special approval under its rules.

Citing section 24 and bypassing the Patent Office's procedures, Doyle brought an independent action in the District Court for the District of Massachusetts to obtain discovery from Sheehan under the Federal Rules of Civil Procedure. The court issued a subpoena duces tecum against Sheehan and, after hearing Sheehan's objections, refused to quash the subpoena and directed Sheehan to produce the requested records and appear to be deposed. In addition to the discovery of Sheehan, Doyle's counsel was able to obtain from the court subpoenae duces tecum against two organizations, also located in Massachusetts, having an interest in the Sheehan patent. Doyle's goal in these ancillary proceedings has been to discover evidence that an abandoned Sheehan patent application in 1957, while disclosing some processes, did not disclose enough to enable Sheehan to claim first invention to the processes for which Sheehan obtained the disputed patent in 1959 and as to which Doyle has a claim to invention dating from late 1957.

While Doyle's discovery was in progress, Sheehan, also invoking section 24, filed a request under Rule 34, Fed. R. Civ. P.,[3] for the production of documents from Doyle and

3. Rule 34(a), Fed. R. Civ. P., provides in pertinent part:

> "Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on his behalf, to inspect and copy, any designated documents * * * or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served. * * *"

Rule 26(b) generally allows a party to obtain discovery of "any matter, not privileged, which is relevant to the subject matter involved in the pending action". Rule 26(b) further provides, "It is not ground for objection that the information sought will be inadmissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence."

his assignee, Beecham Research Laboratories, Inc. (BRL), a British corporation and the real party in interest. Sheehan sought documents of tests and evaluations, made by BRL and to be introduced in interference testimony, concerning the sufficiency of the Sheehan disclosure in its abandoned 1957 application. After considering arguments for and against compelling discovery from the nonresident aliens, the district court ordered Doyle and BRL to produce those documents sought that were not privileged. From this order Doyle now appeals. Doyle objects to the order on grounds of lack of personal jurisdiction and proper venue, as he is a nonresident alien with no ties to Massachusetts. We do not reach these arguments because we hold that section 24 does not confer jurisdiction upon the district court, acting on its own, to grant Rule 34 discovery directly, whether against a nonresident alien or a resident citizen.

A threshold question is the appealability of the district court's discovery order. A discovery order is not usually "final"—and hence not immediately appealable—as the litigation in conjunction with which the discovery is sought is still pending in the district court. 28 U.S.C. §1291. Discovery here, however, is ancillary to the interference in Arlington, Virginia, at the Patent Office, and nothing else was pending at the time in the Massachusetts court. The instant order, therefore, concluded—at least for the moment—the business of the district court. Thus, while the usual policy against piecemeal appellate review dictates otherwise, we must regard the order as final and appealable. *See Natta* v. *Hogan*, 392 F.2d 686, 689 (10th Cir. 1968). (Indeed, Doyle has sought more discovery since this appeal was heard, and the district court's next ruling would likewise be final and appealable.)

The next issue is whether section 24 authorizes the Rule 34 discovery Sheehan seeks. When this appeal was argued, it was accepted among the circuits that had passed on the matter that section 24 authorized discovery beyond that permitted by the Patent Office, and in particular the production of documents from a party by means of a Rule 34 motion. *See, e.g., Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.*, 430 F.2d 1177 (2d Cir. 1968), *aff'g mem.* 314 F. Supp. 235 (D. Conn. 1968); *In re Natta*, 388 F.2d 215 (3d Cir. 1968); *Natta* v. *Hogan*, 392 F.2d 686 (10th Cir. 1968); *Natta* v. *Zletz*, 379 F.2d 615 (7th Cir. 1967); *Gladrow* v. *Weisz*, 354 F.2d 464 (5th Cir. 1965). However, subsequent to argument the Third Circuit ruled, en banc, that section 24 merely confers upon district courts jurisdiction to issue, in aid of the interference, subpoenas as provided in Fed. R. Civ. P. 45(a), (b), (c), (d)(2) & (3), and (f).[4] *Frilette* v. *Kimberlin*, 508 F.2d 205 (3d Cir. 1975) (en banc). The practical effect of this ruling is to permit the compelling of testimony and evidence by the district court which is sought at the proper stage of the Patent Office proceeding, and also to allow the issuance of subpoenas in aid of discovery as authorized by the Patent Office but not otherwise. *See* note 1 *supra*.

The Third Circuit's decision was a reversal of its position in *In re Natta*, *supra*, and a vindication of Judge (now Chief Judge) Seitz's dissenting opinion in the earlier case. 388 F.2d at 221-23. Unlike that circuit, this circuit has never previously passed on the matters.

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4. Rule 45(d)(1), Fed. R. Civ. P., authorizes the compelling of discovery within the scope of Rule 26(b), *see* note 3 *supra*, and therefore is inconsistent with the existing Patent Office discovery rules for interferences.

Appendix A

We believe that the broad reading which courts have given section 24 over recent years goes beyond what Congress could reasonably have had in mind. The unfortunate effect is to generate self-contained discovery proceedings out of joint with the administrative proceeding to which, ostensibly, they are linked. The arguments and analysis, which we adopt and need not repeat, are well set forth in Judge Seitz's dissent in *In re Natta* and in *Frilette*. We agree that section 24 is simply a provision giving teeth, through the courts' subpoena powers, to authority conferred upon the Commissioner of Patents. Such a reading is consistent with the fact that section 23 confers general authority upon the Commissioner of Patents to promulgate rules with respect to depositions and affidavits; with the tenor of section 24; and with the absence of evidence that any sweeping substantive change was intended in the 1952 redraft of section 24 which introduced the sentence in question. If Congress had intended to erect a freewheeling discovery vehicle totally outside the control of the Patent Office, one would have expected some inkling in the legislative history.

Our decision does not have the effect of precluding broad-based Federal Rules discovery in patent interferences to the extent permitted by the Commissioner, whose rules presently allow such discovery "if justice so requires". *See* note 1 *supra*. Judicial subpoenas that may appropriately aid in any such authorized discovery, as well as to obtain testimony and evidence for use in the proceeding in progress, remain available. Our decision merely precludes use of federal courts as alternative forums of

first resort rather than as forums acting strictly in aid of the primary proceeding.

Sheehan contends that the effect of a decision following the Third Circuit would be to insulate nonresident aliens from ancillary discovery, since a subpoena cannot be served upon them. But ancillary judicial discovery is unnecessary as to parties, since the Commissioner has the power to compel testimony or evidence by the threat of dismissing the application. *See* 37 C.F.R. §1.259. The Patent Office has no power to compel the attendance of nonparty witnesses or to enforce the production of evidence from them, and this need was apparently the main reason that Congress conferred ancillary jurisdiction upon federal courts, with their subpoena power and threat of contempt.

It may nevertheless seem unfair in this case to deny Sheehan discovery against Doyle after Doyle has had the advantage of extensive discovery from Sheehan under section 24.[5] However, we are not inclined to impose our notions of fairness on the agency which has been delegated primary authority to control the interference. Moreover, evidence not taken in accordance with the Patent Office rules will not be considered in determining the interference, 37 C.F.R. §1.271, and in any event a party aggrieved may litigate through *de novo* proceedings in the district court, 35 U.S.C. §135.

Reversed. No costs.

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5. Even during the junior party's testimony period, the junior party may not plunge into the senior party's direct case by issuing subpoenas to the senior party. Such a course would be contrary to the set order of taking testimony.

Appendix B

Judgment of the Court Below

UNITED STATES COURT OF APPEALS

FOR THE FIRST CIRCUIT

No. 74-1318

JOHN C. SHEEHAN,

Plaintiff, Appellee,

v.

DOYLE, *et al.*,

Defendants, Appellants.

JUDGMENT

Entered March 31, 1975

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The order of the District Court is reversed. No costs.

By the Court:

/s/ Dana H. Gallup

Clerk.

[cc: Messrs. Jacobs and Spath.]

Appendix C

Opinion of District Court

UNITED STATES DISTRICT COURT

DISTRICT OF MASSACHUSETTS

[CAPTION OMITTED]

August 9, 1974

GARRITY, J. Upon consideration of the motion to compel discovery and the memoranda, defendants Doyle et al. are ordered to produce those documents not privileged which the plaintiff Sheehan has sought under 35 U.S.C. §24 and Rule 34, Fed. R. Civ. P. In our view these proceedings are not materially different from those in *Vogel* v. *Jones*, 3 Cir. 1971, 443 F.2d 257. If they wish, Doyle et al. may produce these documents in New York rather than Boston.

Doyle et al. shall identify those documents as to which privilege is claimed and state the basis therefor on or before August 20, 1974. Doyle et al. should specifically address the case of *Technitrol, Inc.* v. *Digital Equipment*, N.D. Ill. 1974, 181 U.S.P.Q. 731, if a claim of privilege should raise questions discussed therein.

W. ARTHUR GARRITY, JR.
United States District Judge

Appendix D

Rule 34 Motion

IN THE

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF MASSACHUSETTS

[CAPTION OMITTED]

John C. Sheehan, pursuant to 35 U.S.C. §24 and Rule 34 of the Federal Rules of Civil Procedure, hereby requests:

(a) The party Doyle et al. (Frank Peter Doyle, John Herbert Charles Nayler and George Newbolt Rolinson), and

(b) Beecham Research Laboratories, Ltd., the assignee of the party Doyle et al., as follows:

1. To produce and to permit the party Sheehan, or someone acting in his behalf, to inspect and copy all documents within the possession, custody or control of the above party Doyle et al., Beecham Laboratories, Ltd. and its divisions or its related companies, or any of the attorneys, agents or assigns thereof, relating and/or referring to:

(a) evaluations of the operability or sufficiency of the disclosure of U.S. Patent 3,159,617 to Sheehan, including, but not limited to evaluations of the examples of the patent;

(b) all documents relating and/or referring to, or relied on in the preparation of the affidavits of

John Herbert Charles Nayler, Maurice Soulal and Robert Robinson filed in 1965 in the U.S. Patent Office during the prosecution of Doyle et al. application for patent filed July 13, 1959, Serial No. 826,491;

(c) all documents relating and/or referring to, or relied on in the preparation of the affidavits of John Herbert Charles Nayler and John P. Clayton (including the Appendices attached thereto) filed in 1970 in the U.S. Patent Office during the prosecution of Doyle et al. application for patent filed September 22, 1969, Serial No. 870,771, including but not limited to the work described in these affidavits; and

(d) all documents relating or referring to tests to be used, or capable of being used, and the results of such tests obtained in connection with the evaluations of subsection (a) above and the work described in the affidavits of subsection (c) above, to identify the compounds (i) penicillin V, (ii) 6-aminopenicillanic acid (6-APA) (including its alkali metal and acid addition salts), and (iii) the intermediate compounds prepared in accordance with the step-wise synthesis disclosed in U.S. Patent 3,159,617 to Sheehan and denominated as compounds I, II, III and VIII in that disclosure.

2. To produce and to permit the party Sheehan, or someone acting in his behalf, to inspect, and withdraw as a sample for testing, a reasonable and adequate quantity of

each of the following materials which are within the possession, custody or control of the above party Doyle et al., Beecham Research Laboratories, Ltd. and its divisions or its related companies, or any of the attorneys, agents or assigns thereof:

(a) Chemical product designated as BRL 7750 (see affidavits of John Herbert Charles Nayler, page 3, and of John P. Clayton, page 3, filed in patent application U.S.S.N. 870,771)

(b) Chemical products designated as BRL 7782, 7916, 7954, 7820, 7917 and 7955 (see affidavit of John P. Clayton, page 6 through 10, filed in patent application U.S.S.N. 870,771).

3. Any documents produced under any one of the subparagraphs of paragraph 1 above, but falling within the scope of subsequent subparagraphs need be produced only once.

4. As used above, the term "documents" includes writings, graphs, charts, photographs, phono-records and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices in reasonably usable form, and also all laboratory notebooks, logbooks, reports, all interdepartmental memoranda, instructions, letters, records of oral communications and discussions, and all drafts of documents.

5. If a privilege is to be claimed with respect to any of the documents included within the scope of the above production request, each of such documents for which a privilege is claimed shall be identified as follows:

(a) the date appearing on such document and if no date appears thereon, the answer shall so state;

(b) the name and title of the person who signed such document and if it was not signed, the answer shall so state and shall give the name and title of the person or persons who prepared it;

(c) the name and title of the person to whom such document was addressed and the name and title of each person, other than such addressee, to whom such document or a copy thereof was sent; and

(d) the basis for the claim of privilege with respect to each of the documents so identified.

It is requested that the aforesaid production be made on the first day of April, 1974, at 10:00 in the A.M. at the offices of Kenway and Jenney, 24 School Street, Boston, Massachusetts.

KENWAY & JENNEY
Attorneys for the Party Sheehan
24 School Street
Boston, Massachusetts 02108

Feb. 27, 1974

Of Counsel:

N. DALE SAYRE
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New York, New York 10020

[Certificate of Service omitted in printing.]

Appendix E

District Court Opinion in Doyle Discovery

UNITED STATES DISTRICT COURT

DISTRICT OF MASSACHUSETTS

SHEEHAN v. DOYLE *et al.*

E.B.D. No. 73-140
Decided Nov. 20, 1973

Upon consideration of plaintiff's motion under Rules 26(c) and 45 to quash the subpoena duces tecum addressed to the plaintiff on September 19, 1973, and supporting and opposing memoranda, it is ordered that the motion be denied because the documents requested are clearly relevant and material, plaintiff has shown no prejudice, and allowance of the motion would further delay resolution of the merits of the controversy and invite further procedural skirmishes.

In our opinion, enactment of Rule of Practice 287 (1971) does not diminish the court's jurisdiction under 35 U.S.C. §24. We see nothing in Frilette et al. v. Kimberlin, D. Del. 1973, 358 F.Supp. 493, 178 USPQ 387, indicating that Judge Wright would deny resort to §24 in a situation such as this. Babcock & Wilcox Co. v. Foster Wheeler Corp., 1972, 173 USPQ 480, also relied upon by plaintiff, suggests that where Rule 287 discovery procedures have been ineffective, resort to §24 should be available.

W. ARTHUR GARRITY
United States District Judge